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Ex parte Novitski (BdPatApp&Int) 26 USPQ2d 1389 (1/22/1993)

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**U.S. Patent and Trademark Office, Board of Patent Appeals and
Interferences**

26 USPQ2d 1389

Decided January 22, 1993

No. 92-1680

Headnotes

PATENTS

1. Patentability/Validity -- Anticipation -- Prior art (§ 115.0703)

Claimed method for protecting plants from nematodes is anticipated by prior art reference which, although it does not disclose claimed method in haec verba, does disclose method of inoculating plant with "pseudomonas cepacia type Wisconsin 526," which inherently possesses nematode-inhibiting activity.

Case History and Disposition:

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Appeal from refusal to allow claims 1 through 9 (Elizabeth C. Weimar, supervisory patent examiner; Che S. Chereskin, examiner).

Application for patent filed July 1, 1988, serial no. 07/214,301, by Charles Novitski, Thomas J. McLoughlin, and Howard Atkinson (method for protecting plants from nematodes). From examiner's decision refusing to allow claims 1 through 9, applicants appeal. Examiner's rejection of claims under 35 USC 103 reversed; new ground of rejection under 35 USC 102 entered.

Judge:

Before Goldstein, Winters, and W. Smith, examiners-in-chief.

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Opinion Text

Opinion By:

Winters, examiner-in-chief.

This appeal is from the examiner's decision refusing to allow claims 1 through 9. Claims 10 and 11, which are the only other claims in the application, stand objected to as depending from a rejected claim.

Claim 1 is representative:

1. A method for protecting a plant from plant pathogenic nematodes which comprises the step of inoculating said plant with a nematode-inhibiting strain of *P. cepacia* which strain colonizes said plant.

The references relied on by the examiner are:

Dart et al. (Dart) 4,798,723 Jan. 17, 1989 Sayre, *Journal of Nematology*, Vol. 12, No. 4, "Biocontrol: *Bacillus Penetrans* and Related Parasites of Nematodes", pages 260-269 (1980). Hoitink, *Annual Review Phytopathol*, Vol. 24, "Basis for the Control of Soilborne Plant Pathogens with Composts", pages 93-114 (1986). Mishra et al. (Mishra), *Journal of Industrial Microbiology*, Vol. 2, "Insecticidal and Nematicidal Properties of Microbial Metabolites", pages 267-276 (1987).

The issue presented for review is whether the examiner correctly rejected claims 1 through 9 under 35 USC 103 as unpatentable over the combined disclosures of Dart, Sayre, Hoitink, and Mishra.

OPINION

We shall not sustain this rejection.

In setting forth the prior art rejection under 35 USC 103, the examiner identifies Dart as a "primary" reference. According to the examiner, Dart discloses every feature of the subject matter sought to be patented in independent claim 1 *except that*: (1) Dart does not expressly disclose that his bacterial strains of *Pseudomonas cepacia* type Wisconsin possess nematode-inhibiting activity; and (2) Dart does not expressly disclose a method for protecting a plant from plant pathogenic nematodes. As succinctly stated by the examiner,

Dart et al. differs from the claimed invention in that the usefulness of *P. cepacia* to control nematodes is not disclosed.

See the Examiner's Answer, page 3, last complete paragraph.

The examiner relies on Sayre, Hoitink, and Mishra as "secondary" references which make up for the above-noted deficiency of Dart. According to the examiner, the combined disclosures of the "primary" and "secondary" references would have led a person having ordinary skill in the art to the claimed method for protecting a plant from plant pathogenic nematodes with a "reasonable expectation of success". We disagree.

When all the prior art is considered together, a person having ordinary skill in the art must have a sufficient basis for the necessary predictability of success to sustain a rejection under 35 USC 103. *In re Clinton*, 527 F.2d 1226, 188 USPQ 365 (CCPA 1976). Here, the "secondary" references relied on by the examiner do not teach or suggest that Dart's bacterial strains of *Pseudomonas cepacia* type Wisconsin may reasonably be expected to possess nematode-inhibiting activity. The "secondary" references relate to screening bacteria for nematode-inhibiting activity and, at the most, attribute such activity to several strains of *Pseudomonas* bacteria which are not *Pseudomonas cepacia*. In our judgment, the "secondary" art falls far short of establishing that Dart's bacterial strains of *Pseudomonas cepacia* type Wisconsin would reasonably be expected to possess nematode-inhibiting activity.

Under the provisions of 37 CFR 1.196(b), we enter the following new ground of rejection.

Claims 1 through 9 are rejected under 35 USC 102 as anticipated by Dart.

Dart discloses a method which comprises the step of inoculating a plant with *Pseudomonas cepacia* type Wisconsin 526, which colonizes the plant. As expressly disclosed by Dart, *Pseudomonas cepacia* type Wisconsin 526 displays broad-spectrum antifungal activity and, in this regard, we note appellants' recitation of broad-spectrum antifungal activity in claim 5 on appeal. The purpose of Dart's inoculating step is to achieve a method of protecting a plant from fungal disease. Dart does not expressly disclose that

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Pseudomonas cepacia type Wisconsin 526 possesses nematode-inhibiting activity, nor does the reference expressly disclose a method for protecting a plant from plant pathogenic nematodes.

[1] Nevertheless, on the particular facts of this case, we find that *Pseudomonas cepacia* type Wisconsin 526 inherently possesses nematode-inhibiting activity and that Dart's step of inoculating with *Pseudomonas cepacia* type Wisconsin 526 inherently and necessarily constitutes a method for protecting a plant from plant pathogenic nematodes. In this regard, note particularly appellants' disclosure in the instant specification, page 18, that *Pseudomonas cepacia* type Wisconsin 526 possesses an 18% nematode-inhibition rating. Based on that fact, we find the conclusion inescapable that *Pseudomonas cepacia* type Wisconsin 526 may be accurately classified and described as "nematode-inhibiting".

A fortiori, we find the conclusion inescapable that Dart's method of inoculating a plant with *Pseudomonas cepacia* type Wisconsin 526 constitutes a method of inoculating with a nematode-inhibiting strain of *Pseudomonas cepacia* as recited in independent claim 1 on appeal. Therefore, we find that Dart's method constitutes a method for protecting a plant from plant pathogenic nematodes as recited in claim 1 on appeal. We fully appreciate that Dart does not disclose appellants' claimed method *in haec verba*. Nevertheless, Dart's disclosure fully meets the terms of the claimed method because *Pseudomonas cepacia* type Wisconsin 526 inherently possesses nematode-inhibiting activity.

In their main Brief before the Board, page 11, last paragraph, appellants acknowledge that

nematicidal activity is an *inherent* property of some of isolates within the *P. cepacia* type Wisconsin group disclosed and claimed in the Dart patent [emphasis added]

That acknowledgement is consistent with our finding that *Pseudomonas cepacia* type Wisconsin 526 inherently possesses nematode-inhibiting activity. Again, we note the disclosure in appellants' specification, page 18, that *Pseudomonas cepacia* type Wisconsin 526 possesses an 18% nematode-inhibition rating.

We are mindful that appellants assess nematode inhibition by *in vitro* assays of bacteria-induced immobilization of nematodes, and that "substantial" inhibitory activity is defined as that which causes about 40% or greater nematode immobilization in *in vitro* agar plug assays. We are also mindful of appellants' statement in the instant specification, page 8, that

Strains of *P. cepacia* which display substantial nematode inhibitory activity and which colonize plants can protect those plants from nematode invasion.

In this context, appellants refer to a "cutoff value (40%)" in screening for a strain of *Pseudomonas cepacia* which is suitable for their purposes. See the instant specification, page 18.

We are also mindful that, during patent examination, pending claims must be interpreted as broadly as their terms reasonably allow. *In re Zletz*, 893 F.2d 319, 13 USPQ2d 1320 (Fed. Cir. 1989). As often stated by the CCPA, "we will not read into claims in pending applications limitations from the specification." *In re Winkhaus*, 52 F.2d 637, 188 USPQ 129 (CCPA 1975). Here, claims 1 through 9 do not specify any degree of nematode-inhibiting activity, or any level of protection from plant pathogenic nematodes. We shall not read into these claims limitations from the specification, respecting the degree of at deinhibiting activity or level of protection from plant pathogenic nematodes, which may serve to distinguish the claims over the Dart reference. It is axiomatic that the claims define the patent grant, and it is the function of the claims to patentably define appellants' invention over the prior art.

Nor have appellants established on this record that their "cut-off value" of 40% is recognized by those having ordinary skill in the art as an accurate and appropriate criterion. Appellants have not established that strains of *Pseudomonas cepacia* which possess a nematode-inhibiting rating less than 40%, e.g., 39% or 18%, are *not* nematode-inhibiting strains and do not give rise to any level of protection from plant pathogenic nematodes.

We have previously referred to dependent claim 5, which recites broad-spectrum anti fungal activity. That is the same activity disclosed by Dart. We have carefully reviewed dependent claims 2 through 9, but find no limitations therein which serve to distinguish the instantly claimed invention from the invention disclosed by Dart. Accordingly, the Section 102 rejection set forth herein and based on the Dart reference applies to claims 1 through 9.

In conclusion, we do not sustain the examiner's rejection of claims 1 through 9 under 35 USC 103. We enter a new ground of rejection of those claims under 35 USC 102.

Any request for reconsideration or modification of this decision by the Board of Patent Appeals and Interferences based upon the same record must be filed within ONE MONTH from the date of the decision (37 CFR 1.197). Should appellants elect to have further prosecution before the examiner in response to the new rejection under 37 CFR 1.196(b) by way of amendment or showing of facts, or both, not previously of record, a shortened statutory period for making such response is hereby set to expire TWO MONTHS from the date of this decision.

The examiner's decision is reversed.

REVERSED 37 CFR 1.196(b).

- End of Case -